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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD L. BEERY, II

Appeal 2008-0543
Application 09/954,823
Technology Center 1700

Decided: September 29, 2008

Before JENNIFER D. BAHR, ANTON W. FETTING, and DAVID B.
WALKER, *Administrative Patent Judges*.

WALKER, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 9-28. We have jurisdiction under 35 U.S.C. § 6(b) (2002). Because this appeal includes a record that is not ripe for review and pursuant to 37 C.F.R. § 41.50(a)(1) (2007), we remand this application to the Examiner to take appropriate action consistent with our comments below. 37 C.F.R. §§ 41.35(b) and 41.50(a)(1) (2007).

The Examiner must make specific findings as to claim construction. At present, the Examiner's position lacks the requisite specificity on the question of claim construction necessary for us to make a fair review of the merits of the *prima facie* cases of anticipation and obviousness. *See Gechter v. Davidson*, 116 F.3d 1454, 1457, 1460 n.3 (Fed. Cir. 1997) ("In the present case, the Board's opinion lacks a claim construction, makes conclusory findings relating to anticipation, and omits any analysis on several limitations.").

The issues are whether Katz (US 6,055,513) anticipates claims 9-23, 25, 26, and 28 and renders obvious claims 24 and 27. These issues turn on the broadest reasonable construction to be given the claims in light of the Specification as they would be interpreted by one of ordinary skill in the art. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). However, here, no claim construction analysis has been made.

Rejection of claims 9-23, 25, 26, and 28 under 35 U.S.C. § 102(b) as anticipated by Katz.

The Appellant argues several of the claims separately, in each case arguing that nothing in the text cited by the Examiner discloses the disputed limitation. In each case, Appellant invites the Examiner to point out with particularity what portions of the cited text correspond to the disputed limitation as recited in the claim. According to the Appellant, the Examiner has failed to establish the factual evidence necessary to establish a *prima facie* case of anticipation and Katz fails to disclose or suggest elements of each of the disputed claims, as described more fully below.

With respect to claims 9 and 17, the Appellant argues that the Examiner has not shown where Katz teaches 1) "receiving, in a computing

system, a signal identifying a first product associated with an order”; 2) “associating a first product identifier with the first product”; and 3) “presenting, via a user interface, one or more promotions when one or more promotions for at least a second product are associated with the first product identifier.” The Examiner respectively cites 1) col. 15, ll. 38-65 and col. 22, ll. 31-45; 2) col. 15, ll. 38-65, col. 22, ll. 31-45, and col. 24, ll. 31-49; and 3) col. 13, ll. 27-51; col. 17, l. 37 – col. 18, l. 15; col. 23, l. 62 – col. 25, l. 55; and col. 26, l. 66 – col. 27, l. 21 in support of these limitations. The Examiner’s response (Answer 7) fails to address where in the cited passages the disputed claim limitations are explicitly or inherently taught.

With respect to claims 10 and 18, the Appellant argues that the Examiner has not shown where Katz teaches “determining, based on the first product identifier, whether one or more promotions for at least a second product are associated with the first product identifier.” The Examiner cites col. 23, l. 62 – col. 25, l. 55 in support of this limitation, which is also cited with respect to the third limitation of claim 9 above. The Examiner’s response (Answer 8), which additionally cites to col. 22, ll. 31-45, col. 24, ll. 31-49, and Fig. 6, fails to address where in the cited passages the disputed claim limitations are explicitly or inherently taught.

With respect to claims 11 and 19, the Appellant argues that the Examiner has not shown where Katz teaches “comparing the first product identifier with a list of product identifiers associated with promotional offers.” The Examiner again cites col. 23, l. 62 – col. 25, l. 55 in support of this limitation. The Examiner’s response (Answer 8) fails to address where in the cited passages the disputed claim limitations are explicitly or inherently taught.

With respect to claim 12, the Appellant argues that the Examiner has not shown where Katz teaches “wherein a promotion is associated with a combination of one or more product identifiers.” The Examiner again cites col. 23, l. 62 – col. 25, l. 55. The Examiner’s response (Answer 9) fails to address where in the cited passages the disputed claim limitations are explicitly or inherently taught.

With respect to claims 13 and 20, the Appellant argues that the Examiner has not shown where Katz teaches “presenting one or more replacement products in the user interface.” Examiner again cites col. 23, l. 62 – col. 25, l. 55. In response to the Appellant’s argument, the Examiner correctly found that the feature of offering replacement products in the upsell telemarketing method is taught by Katz (Answer 9, citing Katz, col. 27, ll. 47-49). However, claims 13 and 20 depend from claims 9 and 17 respectively, and the ambiguity in the Examiner’s analysis of the disputed limitations of the independent claims must be resolved before the rejection of claims 13 and 20 can be properly considered.

With respect to claims 23 and 26, the Appellant argues that the Examiner has not shown where Katz teaches 1) “storing criteria for a promotional offer in a computer-readable memory”; 2) “receiving, in a computing system, a signal identifying a first product associated with a consumer order”; 3) “comparing a first product identifier associated with the first product with the criteria for a promotional offer”; and 4) “presenting a promotional offer in a user interface when the first product identifier corresponds to a criteria for a promotional offer.” The Examiner cites 1) col. 15, ll. 38-65; col. 22, ll. 31-45; and col. 24, ll. 31-49 in support of the first and second limitations above; and 2) col. 13, ll. 27-51; col. 17, l. 37 to col.

18, l. 15; col. 23, l. 62 to col. 25, l. 55; and col. 26, l. 66 to col. 27, l. 21 in support of the third and fourth limitations above. The Examiner's response (Answer 10) fails to address where in the cited passages the disputed claim limitations are explicitly or inherently taught.

After careful review of the extensive passages cited by the Examiner, it is not clear how the Examiner construes the many claim terms challenged by the Appellant. The difficulty we have with the Examiner's position is its failure to specifically point out where in the cited passages there is found a teaching of each of the disputed claim limitations. Moreover, while we appreciate that in evaluating prior art references, it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom (*see In re Preda*, 401 F.2d 825, 826 (CCPA 1968)), in the present instance, we do not view this maxim of patent law as relieving the Examiner of the initial burden of pointing out where the applied prior art teaches or suggests Appellant's invention.

In the present application, Appellant has reasonably challenged (Br. 7-23) the Examiner's findings with respect to the respective claims. In response, the Examiner has merely reiterated, with minor modifications, (Answer 3-6 and 7-10) that each of the limitations is described in the cited portions of Katz, without pointing out where the respective disputed limitations are explicitly found in the reference.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987). The prior art

may anticipate a claimed invention, and thereby render it non-novel, either expressly or inherently. *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002). Express anticipation occurs when the prior art expressly discloses each limitation (i.e., each element) of a claim. *Id.* In addition, “[i]t is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it.” *Id.*

“To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted) (internal quotation marks omitted).

On remand, the Examiner must specifically point to which portions of Katz are believed to disclose each of the challenged claim limitations. To the extent that the Examiner believes any of the claim limitations to be inherent in Katz, the Examiner must present a detailed analysis of why missing descriptive matter is necessarily present in the thing described in the reference, and why it would be so recognized by persons of ordinary skill, without relying on probabilities or possibilities.

Rejection of claims 24 and 27 under 35 U.S.C. § 103(a) as obvious over Katz.

Appellant argues that there is no evidence of record whatsoever to support the assertion in the final Action that claims 24 and 27 are obvious. According to the Appellant,

The Action acknowledges that Katz fails to disclose associating a product identifier with one or more promotional codes, as recited in claim 24. The Action asserts that it would have been obvious to modify the method taught by Katz with the use of promotional codes “since it was known in the art that promotions are identified by codes to provide a way of tracking the promotions.” However, the Action fails to cite any references to support the assertion of obviousness or to assert Official Notice. In sum, there is no evidence of record to support the assertion. Therefore, the rejection is improper and must be withdrawn. (See MPEP 2144.03).

(Br. 25).

The Examiner disagreed because

the Katz et al. reference teaches the future of providing promotional items such as coupons associated with the primary transaction, “[the upsell is an] offer of a good or a service, or to a coupon, ticket, card or other promotional material having a variable or designated value for the purchase, lease or other acquisition in the future of a good or a service” (col. 18, lines 7-11 - also see col. 27, lines 17-21) and it is well known in the art to use a code such as a barcode as an identifier. It would have been obvious to a skilled artisan in the marketing art to include code as a tracking feature to ensure proper matching and verification during redemption of the promotion.

(Answer 11). Although the Examiner addresses the obviousness of including promotional codes as tracking features, claims 24 and 27 depend from claim 23, and the ambiguity in the Examiner's analysis of disputed limitations of the independent claim must be resolved before the rejection of claims 24 and 27 can be properly considered. To the extent that the above directed analysis affects the Examiner's position regarding the obviousness of claims 24 and 27, this analysis should be made explicit to facilitate review. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

ORDER

Accordingly, it is ORDERED that the application is remanded to the Examiner:

- 1) to provide a claim construction analysis;
- 2) to clarify where specifically the prior art teaches each of the limitations of each of the disputed claims; and
- 2) for such further action as may be appropriate.

REMANDED

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